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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/076,956	02/19/2002	Shuichi Hirayama	SN-US025009	3435

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EXAMINER
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STASHICK, ANTHONY D

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 01/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/076,956	<b>Applicant(s)</b> HIRAYAMA, SHUICHI	
	<b>Examiner</b> Anthony Stashick	<b>Art Unit</b> 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 9/6/05 and the notice mailed 10/28/05.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 6-13 and 15-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-13 and 15-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11/25/02 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

## **DETAILED ACTION**

### ***Finality Of Previous Office Action***

1. Based upon the Pre-Appeal Conference decision mailed October 28, 2005, the finality of the previous Office Action has been withdrawn and prosecution of the application has been reopened. An Office Action on the merits of the pending claims is set forth below. Accordingly, claims 6-13 and 15-28 are still pending in the application.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 6-7, 9-13, 17-21, 23 and 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pozzobon 6,012,236 in view of Garbuio 3,925,916 and Clement et al. 5,746,015. Pozzobon '236 discloses a boot liner 2 with a sole portion (see Figure 1, sole portion is that portion located under the upper portion in the figure); the boot liner 2 having an upper portion (see Figure 1) having a foot section fixedly coupled to the sole portion (see Figure 1); an ankle section extending upwardly from the foot section (also see Figure 1, boot upper is tall enough to cover the ankle); a leg section extending upwardly from the ankle section (see Figure 1, that portion of the upper above the ankle); the upper portion including a thermoformable layer 3, 103 located on an inner side and an outer side of the ankle section (inner side of ankle section is the side of the user's foot that faces the other foot, i.e. medial side of the foot; outer side of the ankle section is that side of the boot that faces what is usually called the lateral side of the foot); the thermoformable layer extends along the foot section (see Figures 1 and 2, thermoformable layer 3, 103 is shown in Figure 1 and Figure 2 shows it extending along the foot); the

thermoformable layer 3, 103 extends along the leg section (see Figure 2); the sole portion being made of the thermoformable material (same as the upper as it is the closed bottom portion of the upper). Pozzobon '236 does not teach the banana-shaped pads located near the ankles and the limitations associated with the banana-shaped pads. Garbuio '916 discloses a first banana-shaped pad 108 located in the outer side of the ankle section; a second banana-shaped pad 108 located in the inner side of the ankle section; the banana-shaped pads made of different material (polyurethane) than the upper (made of polyethylene) and formed of polyurethane; the upper portion includes a foam layer disposed on an interiorly facing side of the thermoformable layer (A, the inner boot layer or medial side of the boot); the upper portion includes an outer layer disposed on an exteriorly facing side of said thermoformable layer (A, the lateral side of the boot); the sole portion is a separate member that is coupled to the foot section of the upper portion (see Figure 1); the sole portion is constructed of a flexible material (see col. 2, lines 8-15); the sole portion includes an outer sole section that is fixedly coupled to said foot section of the upper (see Figure 1, sole outer sole attached to the upper); the outer sole section of the sole portion includes an exterior layer of PVC material; the outer sole section of the sole portion further includes an interior thermoformable layer; the banana-shaped pads have a maximum vertical height and a maximum horizontal width that is approximately equal to the maximum vertical height (see Figure 1). Garbuio '916 teaches that it is desirable to have these pads located on the inner boot to allow for a better and more snug fit of the boot to the user's foot. Therefore, it would have been obvious, to one of the ordinary skill in the art at the time the invention was made, to place banana-like pads, such as that taught by Garbuio '916, on the liner of Pozzobon '236, to aid in better fitting the liner to the user's foot to better translate the forces applied to the sole of the boot. With respect to the thickness of the first and second banana-shaped pads being thicker than the thermoformable layer, Garbuio '916 teaches that the pair of elastic pads 8 could be made of the same material as that of the core 4. As shown in Figure 4, the core material 4 is thicker than the thermoformable layer 3 and therefore, the pads 8 of Garbuio '916 would be thicker than the

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thermoformable layer, as taught by Garbuio '916. The references as applied immediately above disclose all the limitations of the claim except for the upper portion including an inner layer disposed on an interiorly facing side of the thermoformable layer with the first and second banana-shaped pads located between the thermoformable layer and the inner layer. Clement et al. '015 teaches that the upper portion of a liner can have an inner layer 12 disposed on an interiorly facing side of an outer upper layer 11 with padding 5 located there between. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to place an inner layer inside the thermoformable layer with the banana-like pads located there between to provide for better and proper cushioning of the boot on the user's foot.

4. Claims 8, 15, 16, 22, 24-25 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied above in view of Breuner 5,775,006. The references as applied above disclose all the limitations of the claims except for the tightening device fixed to the upper with a first strap portion overlying a part of the first banana-shaped pad and a second strap portion overlying a part of second banana-shaped pad and the tongue and inner sole. Breuner '006 teaches that an inner sole section 46 can overlie the outer sole portion 14 to aid in gaining user comfort. Breuner '006 further teaches that a boot liner can have a tongue 48 attached thereto to close the slit in the boot to prevent ingress of unwanted material into the boot. Furthermore, Breuner '006 teaches that a strap portion can overlie a boot insert and aid in attaching the outer boot to the inner boot, thereby closing the inner boot and aiding in the prevention of ingress of unwanted material with the tongue. Therefore, it would have been obvious, to place a tongue on the inner boot upper as well as straps to attach the outer boot to the inner boot and prevent the ingress of material into the boot.

*Response to Arguments*

5. Applicant's arguments filed on September 8, 2005 with the Request for Pre-Appeal Conference have been fully considered but they are not persuasive. Firstly, with respect to the thickness of the banana-shaped pad argument, that is addressed with respect to Garbuio '96 above. Applicant further argues that claims 8 13 and 28 require that "a first banana-shaped pad located in said outer side of said ankle section, and a second banana-shaped pad located in said inner side of said ankle section...". Applicant further argues that Garbuio '916 does not show the pad 8 in the liner as shown in Figure 2 because the pad is not part of the liner. It appears that the applicant is arguing more than that which is claimed. The claims only require that the pad be located in the inner and outer sides of the upper, but do not require the pads to be part of the upper. If applicant would want the banana-shaped pads to be part of the liner, the claim should contain language similar to the following: --a first banana-shaped pad located as part of the outer side layer of the ankle section, and a second banana-shaped pad located as part of the inner side layer of the ankle section of the upper." This would clearly state that the banana-shaped pad is part of the outer side ankle layer and inner side layer of the liner. When reading the use of the terms inner side and outer side with respect to the thermoformable layer, this same reading of "in said outer side" and "in said inner side" was given to the claims to be consistent with the previous use of the terms. In Garbuio '916, the pads are located in the inner side and the outer side, but they are not part of the inner or outer side. This limitation of being part of the inner or outer side is not claimed. With respect to applicant's arguments that Garbuio cannot teach the pad located between a thermoformable layer and an inner layer, this was taught by Clement as noted in the rejection set forth above, which taught to place a cushioning element (wedge or pad 5) between the layers of the inner boot in the ankle area of the inner boot. When using this teaching with respect to Pozzebon in view of Garbuio, it would teach to place the banana-shaped padding of Garbuio in the ankle area of the inner boot of Pozzebon between the inner and outer layers, the outer layer being the thermoformable layer as described in the rejection set forth above.

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Lastly, the applicant argues that Bruener does not teach the strap portions fixed to the inner boot and does not disclose the strap portions overlying banana-shaped pad located in the ankle portion. Bruener teaches a strap portion fixed to the upper portion, when the strap is tightened, that would overlap in the area of the banana-shaped pads of Garbuio if used as suggested in the combination of the references. Bruener is not required to specifically state that the strap portions overlie a banana-shaped portion, but it teaches if these straps were used in the combination suggested, they would overlie that area in which the banana-shaped pads would lie. Since the yokes of Bruener cover the ankle area, they would overlie any pad located in the ankle area if these same straps as were used on the combination as taught above. Therefore, this combination meets the limitations of the claims.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Stashick whose telephone number is 571-272-4561. The examiner can normally be reached on Monday through Thursday from 8:30 am until 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Anthony Stashick

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Primary Examiner  
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